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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,904	02/21/2002	Georg Steinbichler	H55-062 US	5230

21706 7590 10/01/2003

NOTARO AND MICHALOS  
100 DUTCH HILL ROAD  
SUITE 110  
ORANGEBURG, NY 10962-2100

EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,904

Applicant(s)

STEINBICHLER, GEORG

Examiner

David L. Sorkin

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04/04/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference signs not mentioned in the description: "17" and "18". While "18" is present in the claims, it should be included in the remainder of the specification. "17" is not mentioned at all.
3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure should have a "BRIEF DESCRIPTION OF THE DRAWINGS" section. See 37 CFR 1.77.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendry (US 4,043,715). Regarding claim 1, Hendry ('715) discloses an apparatus with injectors (44) which open into the mixing stage of a screw (3) characterized in that

Art Unit: 1723

disposed immediately upstream of the injectors is a metering piston (see col. 3, line 42). While claim 1 discusses intended operations of the apparatus and material intended to be used with the apparatus, applicant is advised that "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967). Also, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim" *Ex parte Thilbault*, 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 2, the metering piston is part of a pressure booster (38) (see col. 3, lines 41-42).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendry ('715). The apparatus of Hendry ('715) was discussed above with regard to claim 1. While Hendry ('715) does not explicitly disclose a pressure sensor, Hendry ('715) discloses quantitative values of pressure within the apparatus (see col. 4, lines 16-20). It is considered that the disclosure of such quantitative pressure values would have suggested a pressure sensor to one of ordinary skill in the art.

9. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyritsis et al. (US 3,697,204). Regarding claim 1, Kyritsis ('204) discloses an apparatus

with an injector (56) which opens into the mixing stage of a screw (6) characterized in that disposed immediately upstream of the injector is a metering piston (50). While claim 1 discusses intended operations of the apparatus and material intended to be used with the apparatus, applicant is advised that "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, supra. Also, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim" *Ex parte Thilbault*, supra. Nonetheless Kyritsis ('204) explicitly discloses that the travel speed of piston (50) is proportionally greater, the greater is the return travel speed of the screw (see col. 5, lines 3-31 and col. 6, lines 55-60). However, Kyritsis ('204), rather than disclosing plural "injectors" as required by claim 1, only explicitly discloses a single injector. However, it has been held in *In re Harza* 124 USPQ 379 (CCPA 1960) and in *St. Regis Paper Co. v. Bemis Co., Inc.* 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977), that such duplication of parts would have been obvious to one of ordinary skill in the art. Regarding claim 2, the metering piston is part of a pressure booster (28).

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kyritsis et al. (US 3,697,204) in view of Loichen (US 3,771,698). The apparatus of Kyritsis ('204) was discussed above with regard to claim 1. Kyritsis ('204) does not disclose a pressure sensor. Loichen ('698) teaches a pressure sensor (see col. 4, lines 50-55). It is considered that it would have been obvious to one of ordinary skill in the art to have provided that apparatus of Kyritsis ('204) with a pressure sensor as taught by Loichen

Art Unit: 1723

('698), because Kyritsis ('204) recognizes the importance of correct pressure throughout the reference (see the abstract for example).

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David Sorkin



CHARLES E. COOLEY  
PRIMARY EXAMINER